

Remarks

In response to the rejections of the current Official Action, those rejections are respectfully traversed for the following reasons

Preliminarily it is noted that two United States patent publications are applied in the rejections as anticipating references based on their filing date. As no obviousness rejection is made with respect to these references, the common ownership of this application with those publications is understood to be recognized. Accordingly, under 35 U.S.C. § 103 (c) two publications are not prior art with respect to obviousness. Similarly, this is supported by Section 706.02(l) of the “Manual of Patent Examining Procedure” (MPEP). This affirms that this invention was subject to an obligation of assignment of full ownership to Lexmark International, Inc., the assignee of the foregoing two publications, at the time this invention was made.

Claims 1-8 and 15 are rejected as anticipated by U.S. 2004/0127619 by Sun et al. However, these claims require the pigment to be at least about 4 percent by weight of the ink. Although the reference has a range encompassing 4 percent by weight, it is well settled that the disclosure of a range does not destroy the novelty of specific amounts within the range. See MPEP 2144.05, Obviousness of Ranges. Accordingly, the anticipation rejection is not supported by the reference and should be withdrawn.

Claims 1-8 and 15 are rejected as anticipated by U.S. Patent No. 6,652,634 to Akers, Jr. et al. As with the foregoing rejection, the at least about 4 percent by weight of pigment limitation is only found in this reference as encompassed by a range. As it is well settled that the disclosure of a range does not destroy the novelty of specific amounts within the range, the anticipation rejection is not supported by the reference and should be withdrawn.

Claims 1, 3, 9, 11-12, and 14-15 are rejected as anticipated by U.S. 2004/0102541 by Sacoto et al. As with the foregoing two rejections, the at least about 4 percent by weight of

pigment is only found in the reference as encompassed by a range. As it is well settled that the disclosure of a range does not destroy the novelty of specific amounts within the range, the anticipation rejections is not supported by the reference and should be withdrawn.

Claims 9-14 are rejected as obvious over the foregoing U.S. Patent No. 6,652,634. The rejection applies dispersants D and E of this reference, with molar ratios of 9:1:1 and 15:1:1, respectively. Claim 9, the independent claim of this rejection limits the ratio to at most 3:1 by mole of the MAA to TRISA and NPHPPG combined. D is 4.5 to 1 (i.e., 9 divided by 2), well above the claimed amount, and E is 7.5, even more above the claimed amount. Thus, the closest embodiments with respect to the claims do not overlap the claims with respect to this important ratio, but is well above the ratio of the claims. The general ranges of the reference could apply to dispersants of hydrophobic and hydrophilic components found in the reference that differ from those of dispersants D and E of the reference

Moreover, as discussed in the foregoing, the at least about 4 percent by weight pigment limitation is not met except as found in a range. The example of the reference is 3% (col. 12, listing starting at line 20). Motivation to select a higher amount of pigment cannot be assumed, as elements of the claims, specifically the dispersant as just discussed, are unique with respect to obviousness. Thus, the rejection of independent claim 9 for obviousness is not supported and should be withdrawn.

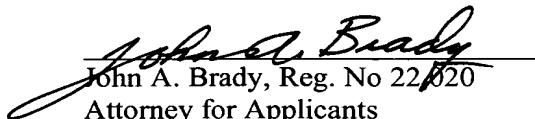
Although dependent claim 10 alone adds a 16 to 1 ratio which is seemingly met by E, that is merely one element of claim 10 and the at most 3:1 element of claim 10 derived from claim 9 is clearly not met. Similarly, the 15 to 2 ratio of claim 11 is merely one element of claim 10 and the at most 3:1 element of claim 11 derived from claim 9 is clearly not met. On this record claims 12 through 15 take their patentability from the patentability of the claims 9-11 from which they dependent, respectively.

The at least 4 percent by weight pigment claim element is clearly a material element of this invention. Thus, page 2, lines 9-11 of the specification state: "To improve the color strength (intensity) of color pigments, the pigment loads for cyan, magenta, and yellow are 4% or greater by weight of the weight of the ink."

Reconsideration is respectfully requested, followed by allowance of claims 1-15, all of the pending claims.

Respectfully submitted,

Charles Edward Akers, JR. et al.


John A. Brady, Reg. No 22,020
Attorney for Applicants
Lexmark International, Inc.
Intellectual Property Law Dept.
740 W. New Circle Road
Lexington, KY 40550
(859) 232-4785